

Appl. No. 11/267,832

Amdt. dated May , 2008

Reply to Office Action of 01/24/2008

### **REMARKS/ARGUMENTS**

Reconsideration of the present application, as amended, is respectfully requested. As a result of the present amendment, claims 25-29, 31-46 and 51-53 are presented in the case for continued prosecution. Support for new claims 51, 52 and 53 can be found, for example in prior claims 40, 44 and 45 respectively and in the application as filed.

Claim 30 was rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response thereto, the claim has been cancelled.

Claims 32 and 45 were rejected under 35 USC 112, second paragraph, as being indefinite to failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, all claims containing "preferably" have been amended to delete the language objected to by the Examiner.

Claims 47-50 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, these claims have been cancelled.

In response to the Examiner's inquiry concerning the joint inventors, applicants respectfully submit that the invention was made commonly by all of the named inventors.

In response to the objection made by the Examiner concerning the IDS, the undersigned will submit a substitute PTO form 1449 which correctly lists the non-patent literature under separate cover.

Claims 25-50 were rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Wittenbrink (WO 01/74969 A2).

In order to maintain an anticipation rejection under 35 U.S.C. § 102, the prior art must disclose each and every element of the rejected claims with sufficient clarity to prove its existence in the prior art. Applicants respectfully submit that the claimed invention is not anticipated by Wittenbrink

As a result of this response, composition claim 25 and process claim 31, as well as all claims dependent thereon have been amended to overcome the rejection based on Wittenbrink and it is urged that the claimed invention is distinguishable over the teachings of Wittenbrink. An important difference between the claimed invention and Wittenbrink is the fact that the claimed waxes are made according to a process which uses a catalyst based on a  $\beta$ -zeolite as the support material.

Support for these amendments can be found for example on page 5, beginning at line 33, as well as in claim 8 as filed.

Wettenbrink does not disclose the use of zeolites as a catalyst basis, let alone the  $\beta$ -zeolites claimed. As a result of including the beta-zeolite as a basis for the catalyst according to the invention, a strong isomerisation combined with a reduction of hydroseparation is attained.

In response to the anticipated request concerning a comparison of the claimed wax to that resulting from Wittenbrink, Applicants submit that a direct comparison is not appropriate. One can not really compare the results of the process according to the present invention with the results reached by the Wittenbrink reference. This is due to the fact that Wittenbrink fails to disclose that a complete product was reached. Only single fractions ("level") are specifically described by parameters. There is no specific proof that isomerization was really reached. However, if one does attempt a comparison between the present application and the reference, one sees that the melting points of present application (to compare with solidification points

according to the reference) is about 10 grads lower, but the penetration values are for the factor 4 to 20 higher. This shows that the process according to the present invention is much more effective than is obtainable with Wittenbrink.

Since the specific base material in the present process is different, one also sees in the disclosure of the application that the most preferred temperature range is between 230 and 270° C. According to Wittenbrink, however, the temperature preferred is between 286 and 321° C.

The present examples refer to 250 to 270° C. The examples of Wittenbrink refer to 286 to 341° C. This shows that the Wittenbrink process is much more energy consumptive. Thus, the process according to the present application is patentably distinct from the process according to Wittenbrink. Advantages of the product formed as a result of the process are described in the specification. See, our example, page 20, lines 1, through page 23, line 9. The Examiner's attention also drawn to Example 3 and Figures 1-3 for further evidence.

Claims 25-50 were rejected under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Hoek (US 2004/0199040). Hoek describes a process for preparing a microcrystalline wax, but is completely silent with regard to the use of zeolites or the  $\beta$ -zeolite catalysts. As such there is no basis to maintain the rejections based on § 102 (e) or § 103. The claims distinguish thereover for the same reasons set forth above with regard to Wittenbrink.

Claims 25-27, 29, and 31-50 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-21 of copending application No. 10/477,910. In response applicants request that the rejection be held in abeyance such time as there is an indication of allowance of the '910 application.

In the event there are further issues remaining in any respect the Examiner is respectfully requested to telephone attorney to reach agreement to expedite issuance of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Since the present claims set forth the present invention patentably and distinctly, and are not taught by the cited art either taken alone or in combination, this amendment is believed to place this case in condition for allowance and the Examiner is respectfully requested to reconsider the matter, enter this amendment, and to allow all of the claims in this case.

#### Fees

This Response is being filed with a Petition for a One Month Extension of Time and fee required therefor. There should be no additional claim fee for the new claims added in view of the cancellation of claims previously paid for. No further fee is believed to be due. If, on the other hand, it is determined that further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

Respectfully submitted  
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